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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,016	07/11/2003	Douglas Scheffer	P114464	6032
22931	7590	02/02/2006	EXAMINER	
HUGHES LAW FIRM, PLLC PACIFIC MERIDIAN PLAZA, SUITE 302 4164 MERIDIAN STREET BELLINGHAM, WA 98226-5583			ROSS, DANA	
			ART UNIT	PAPER NUMBER
			3722	

DATE MAILED: 02/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/619,016	SCHEFFER, DOUGLAS	
	Examiner	Art Unit	
	Dana Ross	3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 16-19 and 28-34 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20-27 is/are allowed.
- 6) ☒ Claim(s) 1-3 and 10 is/are rejected.
- 7) ☒ Claim(s) 4-9 and 11-15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>5/10/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant has elected, in the response filed 19 December 2005, to prosecute the invention of Invention I, Species I, and has identified the claims that read on the elected embodiment as claims 1-15 and 20-27.

Therefore, Claims 16-19 and 28-34 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention and species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 19 December 2005.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1 and 2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, line 8, states "said rotary drive member having a transverse axis of rotation". It is not clear what frame of reference is being used for the "transverse axis of rotation", and therefore any axis is considered the "transverse axis of rotation".

Claim 2, line 3, recites the limitation "said positioning surface". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 6,079,302 (Gudleske, hereafter '302).

'302 teaches a rotary power saw for simultaneously cutting beveling with a saw blade 24 and beveling blade 30, the power tool with a rear grip portion (see figure 1); the bevel cutting blade 30 (see also figure 10) with a section connected to the saw mounting portion (see figure 2, for example) and a bevel member body with inserts 40 locator member and a rotatable outer and inner diameter (see figure 5, for example).

Examiner notes that claim 1 is replete with intended use and functional terminology such as "adapted", "rotatable", "can be" and "to be". These limitations are not positive limitations as to the actual structure of the invention. Claim 3 also uses the term "movable" which does not provide any positive structural limitations.

6. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 4,633,621 (Weber, hereafter '621).

'621 teaches a saw and beveling device with saw 3 and bevel 2 and 2' mounted together (see figure 6, for example). It is noted that the one beveling device 2' can be considered the locating member for beveling device 2.

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7. Claims 1-3 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 4,180,358 (Uribe, hereafter '358).

'358 teaches a beveling attachment with a beveling cutter 12 and an attachment 10 with roller member 16 for locating the positioning of the bevel cutter 12 (see figure 3)

Allowable Subject Matter

8. Claims 4-9 and 11-15 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claims 20-27 are allowed.

The following is an examiner's statement of reasons for allowance: The prior art neither anticipates nor renders obvious a bevel apparatus as claimed in independent claims 20 or 21, specifically wherein the combination of limitations includes a lateral positioning member which is located adjacent the apex end of the lateral positioning member having a surrounding position to engage a sidewall of a pipe on which a beveling operation is to be performed (claims 20 and 21).

The closest prior art is as discussed above.

Neither '302, 621 or '358 disclose a lateral positioning member which is located adjacent the apex end of the lateral positioning member having a surrounding position to engage a sidewall of a pipe on which a beveling operation is to be performed.

Therefore neither '302, '621 nor '358 anticipate the claimed inventions of independent claims 21 or 22.

Furthermore, there is no prior art either alone or in combination with '302, 621 or '358 that would render obvious the claimed inventions and no motivation found to modify either '302, 621 or '358 to obtain the claimed invention, and furthermore, to do so would destroy the workability of '302, 621 and '358.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

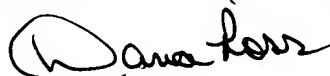
9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dana Ross whose telephone number is 571-272-4480. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Dana Ross
Examiner
Art Unit 3722


dmr